

III. REMARKS

Claims 1-20 are pending in this application. By this amendment, claims 1, 9 and 17-20 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1, 9 and 17-19 are objected to for informalities. Claims 1-19 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-19 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 1, 3-9, 11-18 and 20 are rejected under 35 U.S.C. §103(a) as allegedly being anticipated by Stupek et al. (U.S. Patent No. 5,960,189), hereafter “Stupek,” in view of Taylor (U.S. Patent No. 5,721,824), hereafter “Taylor.” Claims 2 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stupek and Taylor and further in view of “Y2K Compliance and the Distributed Enterprise” by Gowen et al., hereafter “Gowen.” Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stupek and Taylor and further in view of “IMS/ESA Sysplex Data Sharing: An Implementation Case Study” by Boyle et al., hereafter “Boyle.” Claim 19 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stupek and Taylor and further in view of IBM SMP/E as allegedly described on page 8 of the originally filed specification, hereafter “SMP/E.”

A. OBJECTION TO CLAIMS 1, 9 AND 17-19 FOR INFORMALITIES

The Office has objected to claims 1, 9 and 17-19 for alleged informalities. Specifically, the Office has objected to the limitation “to the database” in the claims. Applicant has removed the limitation from the claims. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1-19 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-19 do not satisfy the written description requirement and are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office objects to the use of the limitation “database of all second maintenance items that are known to the database as being able to be installed.” Applicant has amended claims 1, 9, and 17-19 in accordance with the examiner’s stated interpretation of the limitation to recite “database of all second maintenance items that are known as being able to be installed.” Applicant submits that this limitation is explicitly supported, *inter alia*, by Applicant’s original specification (page 8, lines 13-22) and implicitly by the searching of the database for prerequisite items and corequisite items corresponding to each maintenance item of the list entered in step 20. Page 9, lines 6-9. Specifically, the fact that the database is searched to obtain information about the maintenance items being installed on the computer system indicates that the database is a master database of data items known to be installable on the computer system.

As further indication of the global nature of the database, Applicant points out the difference in the specification between the definition of second maintenance items and that of

third maintenance items. Specifically, the specification teaches that the list of third maintenance items "...may be a list of maintenance items needed to be put on to the computer system." Page 9, lines 1-2. In contrast, the definition of second maintenance items in the specification recites "[t]he database application has a database of second maintenance items known as PTF [Program Temporary Fixes]." Page 8, lines 14-15.

To this extent, the definition of second maintenance items of the claimed invention does not have the limitation of that of the third maintenance items, that is that they may be part of an upgrade package. Under common rules of construction, since the limitation that is explicitly included in the definition of third maintenance items is not included in the definition of second maintenance items, the definition of second data items specifically excludes the limitation that it includes only those that are part of a particular upgrade package. Thus, Applicant is justified in indicating the global nature of the database in the claims to distinguish the second maintenance items from the third maintenance items that may be needed to be put on to the computer system. Accordingly, Applicant requests that the rejection be withdrawn.

C. REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Stupek in view of Taylor, Applicant asserts that the combined features of the cited references do not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 9 and 17-19, Applicant respectfully submits that Stupek fails to disclose, *inter alia*, starting in said second host session, a database application having a database of all second maintenance items that are

known as being able to be installed on the computer system. The Office cites passages of Stupek that teach

In addition to the resource upgrades 7, the CD-ROM contains an upgrade database 9, which stores information *about each of the upgrade packages* 6 (e.g., name and location of the package *on the CD-ROM*, description of the upgrades, and instructions for installation of the package to the server), and the individual upgrade objects 8 within each package 6. If the upgrades 7 are provided by an on-line service, the upgrade database 9 will also be provided by the service. Col. 3, lines 44-52, *emphasis added*.

and

The database contains information regarding the dependencies between the package and other upgrade objects or packages. Col. 7, lines 8-10.

Interpreting Stupek solely for the purpose of this response, the upgrade information in the upgrade database of Stupek only concerns the particular upgrade packages that are included on the installation medium, such as the CD-ROM. To this extent, if the upgrade packages of Stupek were, for example, those included in Microsoft OfficeTM, e.g. Microsoft WordTM, Microsoft ExcelTM, Microsoft AccessTM, etc., the upgrade database of Stupek would not necessarily contain information about non-upgrade package applications, such as, for example, Lotus NotesTM.

As such, the upgrade database of Stupek is specifically adapted to the particular application or applications being installed and not of a global nature. To this extent, the upgrade database of Stupek cannot be said to include information regarding all upgrade packages that are known as being able to be installed on the computer system. To this extent, as stated above, database of the second maintenance items of the claimed invention is not limited to data regarding each upgrade package as are the database items of Stupek, but instead is a master database of all maintenance items known to be able to be installed on the system. As such, Stupek does not teach that its database has such a global nature.

The claimed invention, in contrast, includes "...a database application having a database of all second maintenance items that are known as being able to be installed on the computer system, and prerequisite items and corequisite items corresponding to each of said known second maintenance items." Claim 1. As such, the known second maintenance items in the database as included in the claimed invention are not limited, as in Stupek, to data respecting a particular upgrade package, but instead the database includes all second maintenance items that are known as being able to be installed on the computer system, whether the known second maintenance items are included in a particular upgrade package or not. For the above reasons, the upgrade database in Stupek is not taught or suggested by the database that includes known second maintenance items as included in the claimed invention. Taylor does not cure this deficiency. Accordingly, Applicant requests that the rejection be withdrawn.

The Office states that "[m]aintenance items must inherently be known if information regarding them is stored in a database." Office Action, page 8. While this may be the case, this statement does not prove that the database of Stupek contains all items that are known as being able to be installed on a computer system. In contrast, the interpretation that the Office continues to adopt is in opposition to the plain meaning of the phrase as a whole. This is because the Office can only arrive at its interpretation of "all...items that are known as being able to be installed on a computer system" as being, in essence, equivalent to "all of the items in the database are known and can be installed on the computer system" by completely rearranging the phrase in such a way that the meaning of the phrase as a whole is completely changed. Accordingly, Applicant respectfully requests that the Office reconsider its interpretation of the claimed limitation to reflect the globality that is reflected in the claimed phrase as a whole.

The Office also states that “a database with maintenance items that are known to the database as being able to be installed on the computer system, whether the known second maintenance items are included in a particular upgrade package or not” is not supported by the claims. In response, Applicant respectfully submits that the limitation of a database containing all items that are known as being able to be installed on a computer system satisfies the Office’s requirement for support in the claims. This is because the claiming of all items that are known as being able to be installed on a computer system encompasses not only items that are included in a particular upgrade package, but also those that are not. Accordingly, Applicant respectfully requests that the Office reconsider its interpretation of the claimed limitation.

With further respect to independent claims 1, 9, 17 and 18, Applicant continues to assert that Stupek does not teach, *inter alia*, searching said database of known second maintenance items for records matching each of said new third maintenance items to find records that have said prerequisite items and corequisite items. The Office states, in effect, that since the Stupek accesses its database and then retrieves information that includes dependency information, it must necessarily search for this information. However, Stupek specifically states that the retrieval of its information is limited to the following two comparisons: “...a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource.” Col. 4, lines 20-27. As such, Stupek only reports or displays records that meet those comparisons, whether or not dependencies are present, and as such does not specifically search to find records that have dependency information. Col. 4, lines 20-25. Thus, even though dependency information may be included in the records that are found during the

search for the above two comparisons and this dependency information may be used to perform automatic upgrades, Stupek never teaches that the upgrade database is specifically searched for records that have the dependency information. This is further borne out by the fact that a record that is retrieved and reported by Stupek may not contain any dependency information at all. In summary, Applicant submits that Stupek does not search for dependencies, but only for the factors that indicate the occurrence of a package upgrade independent of the presence or absence of dependencies and displays upgrade information whether or not these dependencies exist.

Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With still further respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include entering a first list of new third maintenance items in said maintenance application and adding said corresponding prerequisite items and corequisite items to said first list. The Office admits that Stupek does not expressly disclose this feature. Office Action, page 10. Instead, the Office attempts to rely on Taylor, which teaches “[i]f the dominant package has a dependent package not already installed, the method constructs a trailer script process and an action list. The action list has action entries identifying dependent packages not previously installed.” To this extent, Taylor teaches creating an action list that identifies only dependent packages. Thus, Taylor teaches that its action list of only includes new entries and not that dependent packages are added to an original list of items from which the dependent package was derived. In contrast, the claimed invention includes adding to the “...first list of new third maintenance items...” “...said corresponding prerequisite items and corequisite items.” Claim 1. As such, unlike Taylor, this step expressly adds prerequisite items and corequisite items that have been found in the database search to the original list of new third maintenance items (i.e.,

the items in the original upgrade package to be installed on the system). Neither Stupek nor Taylor teach this feature. Accordingly, Applicant requests that the rejection be withdrawn.

With final respect to claims 1, 9, 17 and 18, Applicant respectfully submits that the cited references do not include thereafter ordering, receiving, and applying said items on said order list after the other steps have been completed. Instead, the retrieval of appropriate upgrade packages from the distribution medium and supplying of the packages to the server upgrader of Stupek occurs at the outset. Stupek does prepare a report but does not indicate that the report is used to order, receive and apply items in the report after the other steps have been completed. In contrast, the claimed invention includes "...thereafter ordering, receiving, and applying said items on said order list." Claim 1. As such, the ordering, receiving, and applying of the items on the order list of the claimed invention does not occur at the outset as in Stupek, but rather thereafter. Taylor does not cure this deficiency. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to new claim 20, Applicant respectfully submits that the cited references do not teach or suggest each and every feature of the claimed invention. For example, the cited references do not teach or suggest that "...the database is stored on a different medium than the maintenance application." In contrast, the database of Stupek is specifically taught as being included in the same medium as its resource upgrades, such as on the same CD-ROM or from the same on-line service. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to independent claims 1, 9, 17

and 18 from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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